

REQUEST FOR RECONSIDERATION  
U.S. Application No. 10/700,547

Claims 1-4, 12-17, 25 and 26 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over newly cited Lin (U.S. Patent No. 5,669,736). Applicant respectfully traverses the prior art rejection.

With regard to independent claims 1 and 14, the Examiner asserts that Lin discloses all of the features of the claimed invention via Figs. 2 and 7. In particular, the Examiner asserts that the impact driving post (Fig. 2) corresponds to the claimed elastic member and the reinforcing steel 13 corresponds to the claimed column members. However, Applicant respectfully submits that it is quite clear that the Lin does not teach or suggest the claimed elastic member or the claimed column members.

Claim 1 requires “disposing a plurality of adjoining column members and an elastic member underground directly underneath or around said structure, said column members forming a hard layer contiguous with said elastic member, wherein said column members have a greater stiffness than the surrounding ground.” Claim 14 requires “an elastic member; and a plurality of adjoining column members disposed around a periphery of said elastic member, said column members forming a hard layer contiguous with said elastic member, wherein said elastic member and said column members are disposed underground directly beneath or around said structure, said column members have a greater stiffness than the surrounding ground.”

Lin discloses a multi-level support cast foundation resist pile with substantially lateral extensions formed before or after the cement has been poured into the pile hole excavation. As shown in Figs. 2 and 3, a conventional cast-in-place foundation pile is formed by partially filling an excavated pile hole with flowable cement and driving an impact driving post which sealingly

REQUEST FOR RECONSIDERATION  
U.S. Application No. 10/700,547

engages the sides of the pile hole into the flowable cement such that the flowable cement expands into the softer soil to form a spherical shaped foundation pedestal in the softer soil. As shown in Fig. 7, a plurality of collar plates 10, 11, 12 and 15 arranged around a cage of reinforcing steel 13 surrounding a concrete foundation pile (see Figs. 4 and 5).

Although the Examiner concedes Lin teach or suggest that the impact driving post is an elastic member, the Examiner asserts that “it would have been obvious ... to modify the method and system of Lin so the impact driving post is elastic, since it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.” However, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to use a impact driving post of elastic material since the impact driving post by necessity must be made of a non-elastic material (i.e., must be rigid) so as to be able to drive the cement into the soil with sufficient force.

Further, the Examiner’s assertion regarding using an impact driving post of elastic material being a matter of design choice is improper. The characterization of certain limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. See *In re Lahu*, (747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984)). Furthermore, an Examiner may not rely on official or judicial

REQUEST FOR RECONSIDERATION  
U.S. Application No. 10/700,547

notice at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. See *Ex parte Cady*, 148 U.S.P.Q. 162 (Pat. Off. Bd. App. and Inter. 1965).

Moreover, the impact driving post is not part of the foundation pile since it is removed from the hole after it is used to drive the soft cement into the soil. Thus, the impact driving post will not be disposed underground directly beneath or around the structure, as required by the claims.

Lastly, the steel reinforcing members are not “adjoining” as required by the claims. That is, as shown in Fig. 7, the steel reinforcing members do not meet or touch at some point or line as required by the adjective “adjoining”.

Accordingly, Applicant respectfully submits that independent claims 1 and 14, as well as dependent claims 2-4, 12, 13, 15-17, 25 and 26, should be allowable because the cited reference does not teach or suggest all of the features of the claims and one of ordinary skill in the art would not have been motivated to modify the cited reference to produce the claimed invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

REQUEST FOR RECONSIDERATION  
U.S. Application No. 10/700,547

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Christopher R. Lipp  
Registration No. 41,157

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: April 21, 2005

Attorney Docket No.: Q78266